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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GREGORY D. GUDORF

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Appeal 2010-001497[1]
Application 09/785,094
Technology Center 2400

_____

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
JEAN R. HOMERE, *Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL[2]

_____

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) (2002) from the
Examiner's final rejection of claims 1-15 and 17-55. Claim 16 has been
canceled. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We reverse.

Appellant's Invention

Appellant invented a method and system for allowing authenticated
users to store audio files at a central location in such a way that each user
can only download those files uniquely associated with the user's
authentication information. (Spec. 2-3 ¶¶ [0008-0009].)

Illustrative Claims

Independent claims 1 and 52 further illustrate the invention. They
read as follows:

> 1. A method of storing audio files comprises:
> (a) receiving at a central location electronic files
> representing audio signals from a first device,
> (b) associating the audio files with authentication
> identification information of a user,
> (c) storing said audio files at said central location
> on at least a portion of a storage media, said portion uniquely
> associated with said authentication identification information,
> (d) receiving at said central location said authentication
> identification information from a second device,
> (e) transmitting said audio files to said second
> device upon receipt of said authentication identification
> information.

52.   A method for storing audio files for use by multiple users
to prevent access to an authorized user's audio files by other
authorized users comprising:

(a) receiving at a central system a plurality of
electronic files representing audio signals for the purpose of
storing the plurality of files at the central system for
multiple users,

(b) storing a plurality of sets of electronic files
of the plurality of audio files at the central system, each set
being uniquely associated with authentication identification
information of a user,

(c) receiving at said central location authentication
identification information of a user from a device, and

(d) transmitting audio files of a set of audio files
to said device upon receipt of said authentication
identification information of the user;

wherein different stored sets of electronic files of
the plurality of audio files on the central system are
exclusively accessible to different authentication
identification information,

wherein the central location is configured to permit
concurrent submission of the authentication identification
information of the user and audio file identification
information from the device for transmitting at least one of the
audio files to the device, without first transmitting a song
selection list to the device.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of

unpatentability:

Van Zoest   US 6,609,105 B2   Aug. 19, 2003

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Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1.   Claims 52-54 stand rejected under 35 U.S.C. § 112, 1st paragraph as failing to comply with the written description requirement.

2.   Claims 1-4, 6-10, 12-15, and 17-55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Van Zoest.

3.   Claims 5 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Zoest.

Appellant's Contentions

1.   Appellant contends that claims 52-54 comply with the written description requirement. In particular, Appellant argues that the originally filed disclosure supports the limitation of exclusively accessing different stored audio files using authentication information associated therewith. (App. Br. 8-10.) Similarly, Appellant argues that the Specification also supports the limitation of the central location being configured to permit a user to concurrently submit authentication information along with the audio file identification information without first transmitting a song selection list to the user's device. (*Id.* at 11, Reply Br. 4-5.) Consequently, Appellant submits that while the Specification does not contain the exact claim language, one of ordinary skill in the art would reasonably discern therefrom that at the time of the invention Appellant had possession of the claim subject matter. (App. Br. 8.)

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2.   Appellant contends that the submitted documentary evidence and testimonial evidence of prior conception properly disqualify Van Zoest as a prior art reference. (App. Br. 12-16, Reply Br. 5-9.) According to Appellant, the Examiner fails to evaluate the proffered evidence to determine whether, prior to the effective filing date of Van Zoest of January 7, 2000, Appellant had invented downloading audio files previously uploaded onto a storage media portion residing at a central location wherein the storage portion is uniquely identified by user authentication information associated therewith. (*Id.*)

3.   Appellant contends that Van Zoest does not teach a central location being configured to permit a user to concurrently submit authentication information along with the audio file identification information without first transmitting a song selection list to the user's device, as recited in independent claim 52. (App. Br. 17-18.) According to Appellant, Van Zoest discloses requiring a user to log onto an audio file system before the user can subsequently select from a song selection list access to a desired song stored at a central location. Therefore, Appellant submits that Van Zoest requires transmitting a song selection list to the user's device before the user can select a song, as opposed to allowing the user to request a song without having to select it from a song list. (App. Br. 17, Reply Br. 11-12.)

Examiner's Findings and Conclusions

1.   The Examiner finds that while Appellant's Specification discusses the submission of user authentication information as well as the identification of audio file information to a central location, it is devoid of any support for submitting these two types of information to the central location in a concurrent manner, as recited in claim 52. (Ans. 15).

2.   The Examiner finds that the submitted documentary and testimonial evidence is insufficient to show that, prior to the effective filing date of Van Zoest of January 7, 2000, Appellant had possession of the concept of downloading audio files previously uploaded onto a storage media portion residing at a central location wherein the storage portion is uniquely identified by a user authentication information associated therewith, as recited in claim 1. (Ans. 15-17.)

3.   The Examiner finds that Van Zoest's disclosure of a server sending a requested audio file to a user upon validating the user identification information teaches concurrently submitting the user identification information along with audio information, as recited in claim 52. (Ans. 17.)

II. ISSUES

1.   Has Appellant shown the Examiner erred in finding that the originally-filed disclosure does not support the limitations of (1) a plurality of audio files exclusively accessible via different user authentication information associated therewith, and (2) concurrently submitting user

authentication information as well as the audio file identification information
to a central location without first transmitting a song selection list to the
user's device, as recited in claim 52?

    2.   Has Appellant shown the Examiner erred in finding the
documentary evidence and the testimonial evidence do not sufficiently show
that, prior to the effective filing date of Van Zoest of January 7, 2000,
Appellant had possession of the concept of downloading audio files
previously uploaded onto a storage medium portion residing at a central
location wherein the storage portion is uniquely identified by a user
authentication information associated therewith, as recited in claim 1?

    3.   Has Appellant shown the Examiner erred in finding that Van
Zoest teaches a central location configured to permit a user to concurrently
submit authentication information along with the audio file identification
information without first transmitting a song selection list to the user's
device, as recited in independent claim 52?

III. FINDINGS OF FACT

    The following Findings of Fact (FF) are shown by a preponderance of
the evidence.

Appellant's Specification

Appellant's Specification states the following:

> 1.   User storage area 110 is used to store the user music files
> 114 uploaded by the users. Preferably, *each user has a*
> *predefined amount of space allocated to its sole use, and no*
> *other user is permitted unauthorized access to any information*

stored in its particular space. Each user has a User ID 112
which identifies the space allocated to the user.

Specification ¶ [0023].) Emphasis added.

2.   The operation of downloading the music is also shown in
FIG. 4. In this embodiment, the user accesses the content server
70 (such as by logging onto a web page) via PDA 73 which, for
the purposes of this example, shall be considered to be at a
geographic location remote from end user computer 60 (step
220). In other words, although the user uploaded the songs with
one device, the user may download the songs at a different
location with a different device. The user accesses the web site
maintained by content server 70 by using wireless modem 76 in
a manner well known to those of ordinary skill in the art. *The
user next supplies its User ID to content server 70 by entering
the information on a web page displayed on screen 75 (step
222). For example, the user may identify itself as "User1"* (it is
recommended, but not required, that user names be more
arbitrary than a designation of "User1" for security reasons).
Optionally, the song may be identified at the same time as well.
Processor 101 of server 70 searches user storage area 110 to see
whether there is any user associated with that particular ID
(steps 224 and 226). If the user ID is not found, an error
notification is sent to the user to that effect (step 211).

(Specification ¶¶ [0027-0028].) Emphasis added.

3.   Accordingly, *each user is assigned a unique
identification code such that the user (or the entity to whom the
user gives the code) is the only entity that can upload and
download music to and from the storage space allocated to the
use*r. *This identification code is sent with, or before, the steps of
uploading and downloading and is used to verify that the*

> *requester is the user associated with the particular storage*
> *space.* It is not necessary for the server to set aside, in advance,
> actual portions of the storage space to particular users. Rather,
> the files may be first stored (and thus occupy a portion of the
> hard drive of the server) and access permissions set for the file
> set in accordance with the identify [sic] of the user.

Specification ¶ [0031].) Emphasis added.

Appellant's Drawing

4.   Appellant discloses a flowchart indicating that upon a user transmitting authentication information (user ID) along with a valid song (song ID) (222), the requested song can be located and transmitted to the user's device (236) without prompting a songlist (230) to the user for selecting a song (232). (Fig. 4.)

Evidence Appendix

5.   Appellant attests that, prior to January 7, 2000, he conceived the invention as described in attachment Exhibit A (invention disclosure form). (Exhibit B1, ¶ 3.)

6.   The invention disclosure form, entitled "your music.. Anywhere" describes that a better approach for allowing a user of a substantial CD collection to access their music anywhere is to upload all the music from the CD to a secure server in such a way to remotely access it from any device connected to the Internet in a wired or wireless method via streaming or download options. In particular, the secure server checks for

security limitations during the music upload phase, and securely delivers the requested music during the streaming or download phase. (Exhibit A, 1-8.)

      7.   Mr. Beckwitt attests to have worked with Appellant in 1999, and to have discussed with Appellant the invention described in Exhibit A.

      In particular, Mr. Beckwitt declares under oath that he discussed with Appellant that the disclosed system allows users to use their security information (username and password) to uniquely access individual audio files that they previously uploaded to the server thereby associating audio files with the user security information. (Exhibit B4, ¶ 7.)

      8.   Mr. Beckwitt further attests under the penalty of perjury that he discussed with Appellant that the secure server is able to store user's uploaded music on storage media portions at the central server wherein said portions are uniquely associated with the user's security information. (*Id.* at 8.)

      9.   Additionally, Mr. Beckwitt attests under the penalty of perjury that he discussed with Appellant that, upon receiving and authenticating the user security information, the secure server is able to forward a requested music file to the user's device associated with the user's security information. (*Id.* at 8.)

      10.   Appellant confirms having conceived prior to January 7, 2000, the claim features detailed in findings 7-9 above. Appellant further attests that such findings are encompassed by and were intended to be included in the invention disclosure document. (Exhibit B5, ¶¶ 7-9.)

Van Zoest

11.   Van Zoest discloses a method and system for allowing authenticated users to upload audio data from their CD to a central storage location, and to subsequently download previously uploaded audio data from any terminal connected to the Internet. (Abstract.)

12.   In particular, Van Zoest discloses assigning a unique online locker to each authenticated user, and associating the user authentication information with an online locker reserved to upload audio data thereto and download said data therefrom. (Col. 1, ll. 33-50.)

13.   Van Zoest discloses that a server provides a user with a session identifier after the user has logged into his/her account at a selected website. Then, the server validates the user's access by comparing the user's issued session identifier with another identifier stored within a URL for a request that the user selected from the website. Subsequently, the server streams the requested work to the user's device if the work is available. (Col. 20, l. 31-col. 21, l. 3.)

IV. ANALYSIS

Written Description Rejection

Claims 52-54 recite in relevant-parts (1) a plurality of audio files exclusively accessible via different user authentication information associated therewith, and (2) concurrently submitting user authentication information as well as the audio file identification information to a central location without first transmitting a song selection list to the user's device. (Br. 21, App'x.) We address representative independent claim 52.

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Appellant's Specification indicates that the authentication information of each user is uniquely allocated to a predefined amount of space, which other users cannot readily access. (FF. 1.) We agree with Appellant that the cited portion of the Specification amply supports the claim limitation of allowing a user to exclusively access audio files via authentication information uniquely associated therewith. Similarly, we agree with Appellant that the disclosure that authentication information can be optionally transmitted with or at the same time as an identified song selection (FF. 2, 3.) does support the limitation of concurrently submitting the authentication information along with the song identification information. Additionally, we find that Appellant's disclosure supports that the transmission of the audio file identification information can take place without having to first provide a song list to the user's device so long as the input song list is valid. (FF. 4.) Consequently, we find that Appellant's originally-filed Specification and Drawings support the disputed claim limitations set forth above. Appellant has therefore shown error in the Examiner's finding that claims 52-54 fail to comply with the written description requirement.

Prior Art Rejections

Claims 1-15 and 17-52

We find error in the Examiner's finding that Appellant's documentary evidence and testimonial evidence are insufficient to show that Appellant had possession of the claimed invention prior to January 7, 2000. In particular, we do not agree with the Examiner that Mr. Beckwitt's

declaration is speculative. We find it rather persuasive since it corroborates Appellant's declaration as to how the secure server detailed in Attachment A is supposed to function. We thus find credible Appellant's testimony, as corroborated by Mr. Beckwitt's declaration that before the effective filing date (January 07, 2000) of the Van Zoest reference, Appellant conceived the secure server to associate user authentication information with specific storage portions to thereby enable the user to uniquely upload audio information thereto, as well as to download uploaded audio information therefrom. (FF. 5-10.) Therefore, we find that the weight of the evidence before us favors Appellant's position that the claimed invention predates the Van Zoest reference. It follows that Appellant has shown error in the Examiner's rejections of claims 1-15 and 17-52 as being anticipated by or unpatentable over Van Zoest since Appellant has effectively disqualified Van Zoest as prior art for these claims.

Claims 52-54

Appellant does not present evidence to disqualify Van Zoest as prior art for these claims. Therefore, we consider the merits of the rejection. We find error in the Examiner's rejection of claims 52-54 as being unpatentable over Van Zoest. In particular, we agree with Appellant that Van Zoest discloses that, after authenticating a user at a website, presenting the user with a song selection list from which the user selects an audio file for subsequent streaming. The server then locates the requested file, and to subsequently streams it to the user if it is available. (FF. 13.) We find that

Van Zoest's disclosure at best teaches submitting the authentication information and the song identification information in a sequential order, as opposed to "concurrently" as required by claim 52. Further, we find that Van Zoest's disclosure of selecting the song from a song list for submission clearly violates the requirement of claim 52. Consequently, we find that Van Zoest's disclosure does not teach or suggest concurrently transmitting the user's authentication information along with a song request, which is not first selected from a song list. It follows that Appellants has shown error in the Examiner's rejection of those claims.

V. SUMMARY

Appellant has established that the Examiner erred in rejecting claims 1-15 and 17-55. We therefore reverse the Examiner's rejections.

REVERSED

Vsh

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